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10/066,281	02/01/2002	Max Friedheim	1776-11	2057

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EXAMINER	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/066,281
Filing Date: February 01, 2002
Appellant(s): FRIEDHEIM, MAX

Joseph R. Evanns
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/14/09 appealing from the Office action mailed 12/13/07.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct.

NEW GROUND(S) OF REJECTION

Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,471,556	Friedheim	11-1995
4,414,037	Friedheim	11-1983
6,393,212	Hutchinson	05-2002
3,863,841	Berthoud	02-1975

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

NEW GROUND(S) OF REJECTION

Claims 1-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. In claims 1 and 21, as amended on 9/24/07, include a recitation "liquid supply means" which is not introduced in the applicant's disclosure as originally filed. The applicant did not have in possession the structure and its equivalent thereof under the claimed scope of the "liquid supply means."

It is also noted that the appellant's remark filed on 4/24/08, on page 7, in response to the 112 2nd paragraph rejection made under the final rejection of 12/13/07, that the liquid supply means comprises a liquid pickup tube inlet 38, liquid pickup tube 40, pump 72, and reservoir, but in the applicant's brief, on page 11, that such liquid supply means is now presented as the reference numeral 40. It is not clear if the liquid

supply means is the just the tube 40 or in combination along with the inlet 38, the pump 72 and the reservoir. Different structure is now defined to support the liquid supply mean, and such contrary finding stated by the appellant's own presentation further show that the appellant did not have the necessary structure and equivalent thereof to define the scope or limitation under the "liquid supply means." Defining the stated elements as the means plus function during the prosecution stage is a new matter because the appellant did not have such stated scope as originally filed.

Grounds of rejection under final as of 12/13/07 as following:

Claims 1-27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear what element is meant by "liquid supply means". Does this term refer to a source of the liquid supply or the means by the liquid is supplied? The liquid source supply means is interpreted as being a source of liquid supply.

Claims 1-8 and 11-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedheim (US 5,471,556) or Friedheim (US 4,414,037) in view of Hutchinson (US 6,393,212).

Friedheim '556 or Friedheim '037 shows the vapor generator claimed including a vaporization chamber wherein the liquid upon its entry therein is instantaneously

superheated, a volume of liquid provided to the vapor generator by a pump for a controlled stream of vapor at the desired pressure and pressure (see column 1, lines 37-42 of Friedheim '037), and the chamber having an interior surface with grooves or perforations, respectively. The grooves have the depth in the range of 0.030-0.050 inch. Friedheim '556 also shows a liquid input fitting tube 88, a valve 90 which controls the superheated vapor by means of controlling the liquid input amount by use of either a thinner or a thicker cap member 230. Friedheim '037 also teaches that the pump supplies a metered amount of liquid (column 2, lines 39-42).

But neither Friedheim '556 nor Friedheim '037 explicitly shows the liquid supply means, as interpreted as being the liquid supply source, and the control means to control the input liquid during the ongoing input of the liquid.

Hutchinson discloses a vapor generator having a vaporization chamber, the input port, the adjustable control means including a control means (22) for controlling the liquid supply means including a pump (30) which is connected to a liquid supply source (see Figure 11) and to the vaporization chamber, for controlling the input liquid into the vaporization chamber.

In view of Hutchinson, it would have been obvious to one of ordinary skill in the art to adapt Friedheim '556 or Friedheim '037 with the liquid supply means including a liquid source with a control means to also adjustably control the pump to provide the desired metered amount of liquid to achieve the desired controlled superheated steam during the ongoing input of the liquid during the operating process.

Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Friedheim '556 or Friedheim '037 in view of Hutchinson as applied to claims 1-8 and 11-27 above, and further in view of Berthoud (US 3,863,841).

Friedheim '556 or Friedheim '037 in view of Hutchinson discloses the vapor generator claimed except the output control means that can is adjustable to direct the vapor in a plurality of selected positions and the plurality of valves that are adjustable to direct the vapor in substantially perpendicular directions.

Berthoud shows a nozzle output control means that is adjustable to direct the output in a plurality of selected positions with a plurality of valves. In view of Berthoud, it would have been obvious to one of ordinary skill in the art to adapt Friedheim '556 or Friedheim '037, as modified by Hutchinson, with the output control means that is adjustable to direct the output steams in a plurality of selected positions so that the output steams may conveniently be directed in the desired directions of the user.

This examiner's answer contains a new ground of rejection set forth in section **(9)** above. Accordingly, appellant must within **TWO MONTHS** from the date of this answer exercise one of the following two options to avoid *sua sponte* **dismissal of the appeal** as to the claims subject to the new ground of rejection:

(1) **Reopen prosecution.** Request that prosecution be reopened before the primary examiner by filing a reply under 37 CFR 1.111 with or without amendment, affidavit or other evidence. Any amendment, affidavit or other evidence must be relevant to the new grounds of rejection. A request that complies with 37 CFR

41.39(b)(1) will be entered and considered. Any request that prosecution be reopened will be treated as a request to withdraw the appeal.

(2) **Maintain appeal.** Request that the appeal be maintained by filing a reply brief as set forth in 37 CFR 41.41. Such a reply brief must address each new ground of rejection as set forth in 37 CFR 41.37(c)(1)(vii) and should be in compliance with the other requirements of 37 CFR 41.37(c). If a reply brief filed pursuant to 37 CFR 41.39(b)(2) is accompanied by any amendment, affidavit or other evidence, it shall be treated as a request that prosecution be reopened before the primary examiner under 37 CFR 41.39(b)(1).

Extensions of time under 37 CFR 1.136(a) are not applicable to the TWO MONTH time period set forth above. See 37 CFR 1.136(b) for extensions of time to reply for patent applications and 37 CFR 1.550(c) for extensions of time to reply for ex parte reexamination proceedings.

(10) Response to Argument

The appellant argues that the Hutchinson reference teaches away from the claimed invention since the volume output in Hutchinson is primarily accomplished by output variable pressure regulating control valve 48. This argument it not deemed persuasive since it is also noted that the appellant's invention includes a valve member that controls the volume output as disclosed on specification p 5, lines 13-16, and as recited in claims 5-9. The Hutchison reference which also includes an output valve just as the appellant's device does not teach away what the appellant's invention also

includes. However, it is noted that Hutchinson is applied to show that it is known to provide a liquid supply source and a control means to control the liquid supply source along with a pump to further supply the liquid into the liquid vaporizing chamber, and it would have been obvious to modify the applied references of Friedheim ‘556 or Friedheim ‘037 which already shows the instantaneous generating of vapor output in response to the input liquid source which are supplied in a metered amount, which is also can be adjusted or varied with a valve member 90 as illustrated in Frieheim '556.

With respect to the Second declaration filed on 6/28/2006, it is noted that there is no such declaration filed in the application, but it is noted that the appellant filed a declaration on 11/17/2006 which was considered and noted in the office action of 4/10/07. The appellant's argument with respect to the Second declaration is moot, but, arguendo, in response to the appellant's argument, it is noted that while the appellant argues that the liquid input amount in Friedheim ‘037 and ‘556 is preset, it is noted Friedeheim ‘556 clearly shows the adjustable valve 90 that adjusts the liquid input as the present invention does with its valve 41.

With respect to the declaration submitted by Terry Munson, the appellant argues that the examiner has ignored the long-felt unsolved need as stated in the declaration. This argument is not deemed persuasive since it was raised by the examiner why such long-felt need was not solved when in fact the devices as shown in Friedheim '556 and '037 would have achieved the desired control steam with the control means using pumps that supplies a metered amount of liquid as opposed un-controlled non-metered amount. Furthermore, it is noted that Friedheim '556 shows the valve 90 which controls

and adjusts the input liquid amount. Thus, in light of such teachings under the Friedheim references, it was deemed that the declaration lacked sufficient evidence to support the long-felt unsolved need when in fact the Friedheim devices would have solved such need when providing a controlled metered liquid amount.

With respect to the Berthoud reference, the appellant argues that this reference is in a wholly different field and that no explicitly analysis is provided to show the apparent reason or any motivation or suggestion to combine with the Friedheim and Hutchinson references. It is noted that Berthoud is in the same field of endeavor which involves the devices of controlling the output direction of gases. By adapting the output valves of Berthoud, the output direction of the steam of the Friedheim devices would have been further controlled in the predictable result as intended by the appellant.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/SANG Y PAIK/

Primary Examiner, Art Unit 3742

A Technology Center Director or designee must personally approve the new ground(s) of rejection set forth in section (9) above by signing below:

/KAREN M. YOUNG/

Director, Technology Center 3700

Conferees:

/TU B HOANG/

Supervisory Patent Examiner, Art Unit 3742

/Tom Hughes/
TQAS, TC 3700